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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/814,594   | 03/30/2004  | Dylan S. Van Atta    | 005127.00356        | 5894             |
| 22910  | 7590        | 05/10/2006           | EXAMINER            |                  |
| BANNER & WITCOFF, LTD.<br>28 STATE STREET<br>28th FLOOR<br>BOSTON, MA 02109-9601 |             |                      | MORAN, KATHERINE M  |                  |
|  |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3765                |                  |

DATE MAILED: 05/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/814,594

**Applicant(s)**

VAN ATTA ET AL.

**Examiner**

Katherine Moran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 22 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 5-17 and 22-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 18-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>7/15, 10/20/04</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Claims 5-17 and 22-26 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected species, there being no allowable generic or linking claim. Applicant timely traversed the restriction requirement in the reply filed on 2/22/06. Applicant's traversal is based upon Applicant's belief that the five species of the election requirement would not have separate classifications and would not require searches in different fields. The requirement is based upon the Examiner's position that each species is patentably distinct from the others such that each species has varying combinations of mechanical elements such that each species is distinct from the others. Accordingly, the requirement stands. An examination on the merits for claims 1-4 and 18-21 is outlined below.

### ***Specification***

2. The disclosure is objected to because of the following informalities: pg.6, line 4: delete "16" and insert --12--.

Appropriate correction is required.

### ***Claim Objections***

3. Claim 3 is objected to because of the following informalities: line 2: delete "an" and insert --its-- to clarify that the thickness of the outer peripheral portion's inner portion is being claimed. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1, 2, and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Freeman (U.S. 2,515,554). Freeman discloses the invention as claimed. Freeman teaches a swim cap as shown in Figures 1 and 2, comprising a first portion 16 or 11 configured to cover at least a portion of a crown of a user's head and having a first durometer, and a second portion 10 secured to and overlaying the first portion and having a second durometer which is smaller than the first durometer. Freeman teaches the first portion is a thickened rib which extends completely around the free edge and are also formed on the inner surface of the cap with serrations of triangular cross-section to grip the wearer's head. The second portion entirely covers the first portion and extends beyond a peripheral edge of the first portion 16.

6. Claims 1 and 3 are rejected under 35 U.S.C. 102(b) as being anticipated by Howland (U.S. 2,295,659). Howland discloses the invention as claimed. Howland teaches a swim cap 20 comprising a first portion 35 configured to cover at least a portion of a crown of a user's head and having a first durometer, and a second portion 33 secured to the first portion and having a smaller durometer than the first durometer. The outer peripheral portion 34 of the second portion has a thickness greater than that of an inner portion as shown in Figure 6.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Freeman in view of Dodd (U.S. 6,052,825). Discloses the invention substantially as claimed. Freeman discloses the invention substantially as claimed. However, Freeman doesn't teach the first portion formed of PETg or silicone, and the second portion formed of silicone or latex. Freeman's second portion is formed from rubber. Dodd '825 teaches a swim cap 1 formed from silicone or latex and teaches that silicone and latex are both known as waterproof, lightweight, resilient, and flexible materials, with latex being a synthetic form of rubber. Applicant's specification does not disclose the criticality of using these particular materials, and pg. 5, paragraphs 23 and 24 of Applicant's specification teach that PETg and silicone or any other relatively stiff materials would also be suitable, while par. 24 recites that silicone, latex or any other relatively soft, flexible, and stretchy material would also be suitable. Therefore, the most suitable material to use for each portion could have been arrived at through routine experimentation. PETg is known as a highly durable thermoplastic. Therefore, it would have been obvious to one of ordinary skill in the art to form Freeman's first portion of PETg or silicone since each material is highly durable and readily available,

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and it would also have been obvious to form the second portion of silicone or latex since each material is resilient, flexible, and waterproof.

### ***Conclusion***

9. The prior art made of record on the attached PTO-892, and not relied upon, is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications should be directed to Primary Examiner Katherine Moran at (571) 272-4990. The examiner can be reached on Monday-Thursday from 8:30 am to 6:00 pm, and alternating Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert, may be reached at (571) 272-4983. The official and after final fax number for the organization where this application is assigned is (571) 273-8300. General information regarding this application may be obtained by contacting the Group Receptionist at (571) 272-3700.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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May 8, 2006



Katherine Moran

Primary Examiner, AU 3765